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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK ITWARU

Appeal 2009-006760
Application 10/081,265
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Mark Itwaru (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1, 4-26, and 28-36, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION[2]

We AFFIRM-IN-PART.

THE INVENTION

The Appellant invented a method to enhance the security of network transactions. Specification 1.

An understanding of the invention can be derived from a reading of exemplary claims 1 and 22, which are reproduced below [bracketed matter and some paragraphing added].

> 1. A method for enhancing security of network transactions, comprising:
>
> [1] receiving information relating to a pending transaction between a vendor server and a client;

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[2] Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed April 30, 2007) and Reply Brief ("Reply Br.," filed September 19, 2007), and the Examiner's Answer ("Ans.," mailed August 9, 2007), and Final Rejection ("Final Rej.," mailed May 9, 2006).

[2] receiving private network access information for accessing a private network and a transaction identifier from a transaction server system;

[3] provisioning a set of computer readable instructions with transaction-specific information comprising said transaction identifier and said private network access information;

[4] sending a message addressed to said client over said public Internet with said set of computer readable instructions having said transaction-specific information, said set of computer readable instructions comprising access instructions for connecting said client to said transaction server system on said private network such that sensitive information relating to said transaction is directed to said transaction server system.

22. A method for enhancing security of network transactions, comprising:

[1] receiving information relating to a pending transaction over a secure link, said information including access information for a data product, and a purchase amount;

[2] determining an appropriate chargeable telephone number based upon said purchase amount;

[3] storing a transaction identifier, said telephone number, and said access information; and

[4] returning said transaction identifier and said telephone number over said secure link.

THE REJECTIONS[3][4][5]

The Examiner relies upon the following prior art:

Klingman	US 5,729,594	Mar. 17, 1998
Apte	US 5,778,173	Jul. 7, 1998
Paik et al.	US 6,675,008 B1	Jan. 6, 2004
Underwood	US 6,704,873 B1	Mar. 9, 2004
Matsuda et al.	US 2003/0195843 A1	Oct. 16, 2003
Furman et al.	EP 0926611 A2	Dec. 17, 1998

Claim 36 stands rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

Claims 1, 4-16, 18-21, and 34-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Apte.

Claims 22-25, 28, and 30-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Furman.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Apte and Klingman.

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[3] The Examiner rejected claim 27 under 35 U.S.C. § 102(e) as being anticipated by Underwood, however, this claim as been cancelled. App. Br. 5-6. As such, this rejection is moot.

[4] The Examiner has withdrawn the previously asserted rejection of claim 36 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Ans. 3.

[5] The Examiner has withdrawn the previously asserted rejection of claim 26 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out

Claim 26 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Apte and Matsuda.

Claim 29 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Furman and Matsuda.

Claim 33 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Furman and Paik.

ISSUES

The issue of whether the Examiner erred in rejecting claim 36 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention turns on whether a person with ordinary skill in the art would have understood what was being claimed by the limitations recited in claim 36.

The issue of whether the Examiner erred in rejecting claims 1, 4-16, 18-21, and 34-35 under 35 U.S.C. § 102(b) as being anticipated by Apte turns on whether Apte describes limitations [3] and [4] of claim 1.

The issue of whether the Examiner erred in rejecting claims 22-25, 28, and 30-32 under 35 U.S.C. § 102(b) as being anticipated by Furman turns on whether Furman describes limitation [2] of claim 22.

The issue of whether the Examiner erred in rejecting claim 17 under 35 U.S.C. § 103(a) as unpatentable over Apte and Klingman turns on whether the Appellant's arguments in support of claim 1 are found persuasive.

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and distinctly claim the subject matter which the Appellant regards as the

The issue of whether the Examiner erred in rejecting claim 26 under 35 U.S.C. § 103(a) as unpatentable over Apte and Matsuda turns on whether Apte and Matsuda describe all of the limitations of claim 26.

The issue of whether the Examiner erred in rejecting claim 29 under 35 U.S.C. § 103(a) as unpatentable over Furman and Matsuda turns on whether the Appellant's arguments in support of claim 22 are found persuasive.

The issue of whether the Examiner erred in rejecting claim 33 under 35 U.S.C. § 103(a) as unpatentable over Furman and Paik turns on whether the Appellant's arguments in support of claim 22 are found persuasive.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Apte

01. Apte is directed to a method and apparatus for performing transactions such as purchases over the World Wide Web. Apte 1:6-10.

02. Apte describes a transaction that begins with a user selecting to purchase a product. Apte 2:44-48. A then vendor generates and transmits a purchase order number to the user and a transaction server that is isolated from the Internet. Apte 2:44-48. The

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invention. Ans. 3.

system uses a proprietary protocol that operates over a telephone link. Apte 2:50-53. The vendor directs the user to contact the transaction server and provides the user with the server's telephone number, which may be an 800 number, and the user's computer initiates contact with the transaction server. Apte 3:47-50, 4:64-67, and Fig. 2. This access information can be displayed on a web page, stored locally on the user computer, or retrieved by the user on a directory located in a secure communication system. Apte 4:1-15. The computer automatically uses the URL of the vendor to attempt to retrieve the number; the computer then automatically attempts to retrieve the number from a locally stored directory; and then prompts the user to enter the number if number has still not been found. Apte 4:18-26. After communication has been established, the user enters the purchase order number and approves the purchase by submitting credit card information. Apte 4:30-34. Once the transaction is complete, the user computer ends the communication session with the transaction server and resumes communication with the WWW. Apte 4:36-40. The user can be provided with software to be executed on the user computer to automatically perform the transition in communication between the WWW and the transaction server. Apte 3:15-20. The communication session between the user computer and the transaction server is configured to appear to the user as a WWW communication such that the user is virtually unaware that the user computer has suspended communication with the WWW and has initiated communication with the

transaction server. Apte 4:44-52. The system can be run in both directions; either the user's computer initiates contact with the transaction server or the transaction server initiates contact with the user computer. Apte. 4:64-67.

Furman

03. Furman is directed to the validation of electronic transactions. Furman 1:5-7.

04. Furman describes a method that begins with a customer placing an order with a vendor by using a computer and connecting to a vender server via the Internet. Furman 5:12-15. The vendor server creates a unique transaction identifier used to identify the transaction and transmits the identifier to the customer via the Internet. Furman 5:34-36 and 5:54-56. The vendor server also transmits a telephone number that the user must call in order to validate the transaction. Furman 5:56-58. The telephone number may be a 900 number that results in a charge to the customer's telephone bill. Furman 6:1-5. The validating system requires the user to enter the transaction identifier and uses the transaction identifier to determine the appropriate vendor. Furman 6:41-44 and 7:6-8. The validation system then connects to the vendor server to retrieve pricing information and transmits the pricing information to the customer on the telephone call. Furman 7:29-31 and 7:39-43. The customer then responds to the validation system on whether the customer accepts or declines the transaction. Furman 7:50-55.

Underwood

05. Underwood is directed to software framework designs and providing a global internetworking gateway architecture. Underwood 1:6-8.

Klingman

06. Klingman is directed to a system providing on-line secure communications using a telephone system or a digital network for performing electronic shopping. Klingman 1:8-13.

07. Klingman describes that a user connects to a networks system to potentially purchase products and upon the selection of an item a telephone number, such as a 900 number, is communicated to the user to complete the transaction. Klingman 7:10-24. Software residing on the user's system automates the transaction operations with little human interaction. Klingman 18:34-37. A router interprets the TCP/IP address from the URL and routes them to the merchant's server. Klingman 18:39-42.

Matsuda

08. Matsuda is directed to systems and methods for conducting electronic commerce between individuals. Matsuda ¶ 0003.

09. Matsuda describes a system where a user contacts a transaction server and provides details surrounding a transaction, including an already established account ID. Matsuda ¶ 0017. The other party to the transaction confirms the details of the transaction and authorizes the transaction. Matsuda ¶'s 0018-0019. In preparing

the transaction, the transaction server will create a message that includes a transaction ID and a period of validity. Matsuda ¶ 0068. The message is sent to the buyer and seller and includes a URL to the transaction server such that the buyer need only click on to the URL to connect to the transaction server. Matsuda ¶ 0069. When contacting the transaction server, the user submits his transaction ID, account ID, and password. Matsuda ¶ 0070.

Paik

10. Paik is directed to a caller information providing apparatus and a caller information transmitting method in a mobile radio communication network. Paik 1:10-13.

11. Paik describes that the related art solves the demand to know who is calling before receiving the call by providing a caller line identification (CLID) service that provides the telephone number and the name of the caller through a display. Paik 1:20-28.

ANALYSIS

Claim 36 rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention

The Examiner found that it is unclear how a client can connect to a WWW server without a modem. Ans. 4. The Appellant contends that the Examiner has failed to point to any portion of claim 36 that fails to distinctly claim the invention. App. Br. 19.

We agree with the Appellant. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986)(citations omitted).

Claim 36 recites displaying access instructions and the transaction ID to the client if the indication of resources indicates that the client lacks a modem. Claim 36 depends on claim 13, which depends on claim 12. Claim 12 recites that the client receives a message over the public Internet and provides access instructions to a private network. That is, a user connects to the public Internet and receives information on the Internet on how to connect to the private network in claim 12. If the user does not have a modem, the user is provided other access instructions in claim 36. As such, a person with ordinary skill in the art would have understood what is being claimed.

The Examiner's rejection and argument seem to be based on the alleged contradiction of how a user is connected to the public Internet to receive access instructions, but then not have a modem to connect to the private network. We find that this is not a contradiction because there are several ways that a user can connect to the public Internet, including the use of a network interface card, and as such a user need not only have a modem to connect to the Internet. As such, the language recited in claim 36 is clear and satisfies the requirements of 35 U.S.C. § 112, second paragraph.

Claims 1, 4-16, 18-21, and 34-35 rejected under 35 U.S.C. § 102(b) as being anticipated by Apte

The Appellant first contends that (1) Apte fails to describe limitations [3] and [4] of claim 1. App. Br. 6-7. The Appellant specifically argues that Apte describes that the vendor directs the user of a computer to contact the transaction server, whereas the claims require directing the user computer to contact the transaction server. App. Br. 7.

We disagree with the Appellant. Limitation [3] requires including transaction specific information, consisting of a transaction identifier and private network access information, in the computer readable instructions. Limitation [4] further requires sending a message over the public Internet with the transaction specific information and computer readable instructions for connecting to a private network.

Apte describes a transaction system that when a user selects an item for purchase on the World Wide Web, the vendor provides the user and a transaction server with a purchase order number. FF 02. Apte specifically describes that the transaction server is isolated from the public Internet. FF 02. The vendor provides the user with the server's telephone number and directs the user to contact the server. FF 02.

Apte explicitly describes that the user's computer has software to initiate connection with the transaction server and the connection from the World Wide Web to the transaction server can be done seamlessly such that the user is unaware of the change in connection. FF 02. That is, the user computer, not just the user, initiates contact with the transaction server and must be automatically connecting to the transaction server in order for a user

to be unaware of the connection. As such, Apte describes limitations [3] and [4] of claim 1.

The Appellant further contends that (2) Apte fails to describe that the private network access information comprises a flat rate telephone number or a fixed charge per minute telephone number and a number of minutes, as per claims 5-6. App. Br. 8. We disagree with the Appellant.

As noted by the Examiner, Apte describes providing the user with the telephone number for the transaction server and the transaction server is on a private network. FF 02. Apte explicitly describes that the telephone number can be an 800 number. An 800 number is a free telephone number. That is, an 800 number has a fixed rate of zero cents per minute. The Appellant has not provided any further rationale to distinguish claims 5-6 from Apte. As such, Apte describes a fixed charge per minute telephone number and the Appellant's argument is not found persuasive.

The Appellant also contends that (3) Apte fails to describe that prior to sending a message with instructions to connect to the transaction system, sending a location of the instructions over the public Internet, as per claims 7-9. App. Br. 8-9. We disagree with the Appellant.

As noted by the Examiner, Apte describes that the user computer first attempts to use the universal resource locator (URL) of the vendor to retrieve the phone number or location of the transaction server. FF 02. If this fails, the user computer attempts to retrieve the number from a locally stored directory. FF 02. Finally, if this attempt also fails the user is then prompted to enter the telephone number for the transaction server. FF 02. As such, prior to sending a message to the user, the location of the

transaction server may be retrieved from the vendor URL, which resides on the public Internet.

The Appellant additionally contends that (4) Apte fails to describe the set of computer readable instructions comprise a second code segment that causes the client to pass transaction-specific information to the transaction server system, as per claim 11. App. Br. 9. We disagree with the Appellant.

Apte describes that the message sent to the user includes transaction specific information, which includes the purchase order number and instructions on contacting the transaction server. FF 02. A user is required to provide transaction specific information, such as the purchase order number, when establishing a connection with the transaction server. FF 02. Apte further describes that the user computer can contain software that seamlessly disconnects from the World Wide Web and connects to the transaction server such that the user is unaware that such a connection has been established. FF 02. As such, the client contains computer software or a code segment that passes transaction specific information to the transaction server.

The Appellant next contends that (5) Apte fails to describe sending a message addressed to the client over the public Internet with a set of instructions having transaction-specific information and prior to sending this message, sending a set-up message with a set of instructions for determining resources of the client for connecting to the private network, as per claim 12. App. Br. 9-10 and Reply Br. 4. We disagree with the Appellant.

As discussed *supra*, Apte describes software that automatically connects the user computer to the transaction server to complete the transaction. FF

02. The software makes a determination of how to connect to the transaction server. FF 02. The Appellant specifically argues that Apte's software does not automatically configure the client. Reply Br. 4.

However, each transaction in Apte has a different purchase order number and each connection to the transaction server requires that purchase order number. As such, each transaction between the user computer and the transaction server is configured with the required purchase order number for that transaction.

The Appellant further contends that (6) Apte fails to describe the limitations recited in claims 13-14. App. Br. 11-12. We disagree with the Appellant.

Claim 13 requires receiving an indication of the resources of the client and provisioning instructions to connecting to the private network based on the indicated resources. Claim 14 only requires the computer readable instructions of claim 1 to include instructions to determining the resources of the client. Apte describes that the software on the user computer attempts to locate the telephone number for the transaction server in the vendor's URL or on a locally stored directory. FF 02. That is, the software is determining the location of the resources needed to connect to the transaction server.

The claims are broadly phrased such that the term "resources" encompass the capability to locate the telephone number of the transaction server. As such, Apte describes determining the resources of the client and instructing the client to perform actions, such as retrieve the telephone number from the local directory, based on the resources of the client.

The Appellant contends that (7) Apte fails to describes sending said information relating to a pending transaction to said transaction server system over a secure link prior to receiving a transaction identifier and private network access information, as per claim 15. We disagree with the Appellant.

Apte describes in detail the process where information is sent to the user computer and the user computer initiates contact with the transaction server. FF 02. However, Apte contemplates that the procedure can be changed such that the transaction server initiates contact with the user computer. FF 02. In such a procedure, the vendor would transmit pending transaction information to the transaction server prior to the receipt of private network access information and a transaction identifier. As such, Apte describes claim 15.

The Appellant also contends that (8) Apte fails to describe the limitations of claim 21. App. Br. 13 and Reply Br. 4-5. We disagree with the Appellant.

Claim 21 recites the same limitations found in claim 14 and the Appellant submit similar arguments in support of claim 21 as submitted for claim 14. As such, the Appellant's arguments in support of claim 21 are not found persuasive for the same reasons as claim 14 discussed *supra*.

Claims 22-25, 28, and 30-32 rejected under 35 U.S.C. § 102(b) as being anticipated by Furman

The Appellant contends that Furman fails to describe determining an appropriate chargeable telephone number based on the purchase amount, as required by claim 22. App. Br. 14 and Reply Br. 5.

We agree with the Appellant. Furman describes a system that validates electronic transactions. FF 03. A vendor creates a transaction identifier and transmits the transaction identifier and a telephone number to the user. FF 04. The telephone number may be a 900 number that results in a charge to the customer's telephone bill. FF 04. However, Furman fails to describe determining an appropriate telephone number based on the purchase amount, as required by limitation [2] of claim 22. Furman specifically fails to indicate whether the telephone number provided to the user is in any part based on the purchase amount. As such, Furman fails to anticipate claim 22.

Since this issue is dispositive as to the rejections towards these claims, we need not reason the remaining arguments.

Claim 17 rejected under 35 U.S.C. § 103(a) as unpatentable over Apte and Klingman

The Appellant contends that Apte and Klingman fail to describe the limitations of dependent claim 17 because Apte and Klingman fail to describes limitations [3] and [4] of independent claim 1. App Br. 12-13. We disagree with the Appellant. The Appellant's argument that Apte fails to describe limitations [3] and [4] of claim 1 was not found persuasive *supra* and is not persuasive here for the same reasons.

Claim 26 rejected under 35 U.S.C. § 103(a) as unpatentable over Apte and Matsuda

The Appellant also contends that Furman fails to describe all of the limitations of claim 26. App. Br. 15-16 and Reply Br. 5-6. We disagree with the Appellant. Claim 26 requires a client to dial and establish a connection with a specific telephone number; send transaction specific information; receive a message with a URL and password; drop the connection; connect to the URL over a public Internet; and display the password.

As discussed *supra*, Apte describes that a user selects an item to purchase from a vendor and then receives a message from the vendor with a URL or telephone number for the transaction server and the purchase order number. FF 02. The user computer then drops the connection with the vendor and establishes a connection with the transaction server. FF 02. As such, Apte describes all of the limitations of claim 26, except for the limitation requiring that the password be displayed after connecting to the URL.

Matsuda describes a system where individuals can perform transactions. FF 08. In communicating with the transaction server, a user submits his transaction ID, account ID, and password. That is, the user enters his transaction ID, account ID, and password and it is displayed to the transaction server. As such, the combination of Apte and Matsuda describe all of the limitations of claim 26.

Claim 29 rejected under 35 U.S.C. § 103(a) as unpatentable over Furman and Matsuda

The Appellant contends that Furman fails to describe determining an appropriate chargeable telephone number based on the purchase amount, as per claim 29, for the same reasons presented in support of claim 22 *supra*. App. Br. 17-18. We agree with the Appellant. The Appellant's arguments were found persuasive *supra* and are found persuasive here for the same reasons.

Claim 33 rejected under 35 U.S.C. § 103(a) as unpatentable over Furman and Paik

The Appellant contends that Furman fails to describe determining an appropriate chargeable telephone number based on the purchase amount, as per claim 33, for the same reasons presented in support of claim 22 *supra*. App. Br. 18-19. We agree with the Appellant. The Appellant's arguments were found persuasive *supra* and are found persuasive here for the same reasons.

CONCLUSIONS OF LAW

The Examiner erred in rejecting claim 36 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

The Examiner did not err in rejecting claims 1, 4-16, 18-21, and 34-35 under 35 U.S.C. § 102(b) as being anticipated by Apte.

The Examiner erred in rejecting claims 22-25, 28, and 30-32 under 35 U.S.C. § 102(b) as being anticipated by Furman.

The Examiner did not err in rejecting claim 17 under 35 U.S.C. § 103(a) as unpatentable over Apte and Klingman.

The Examiner did not err in rejecting claim 26 under 35 U.S.C. § 103(a) as unpatentable over Apte and Matsuda.

The Examiner erred in rejecting claim 29 under 35 U.S.C. § 103(a) as unpatentable over Furman and Matsuda.

The Examiner erred in rejecting claim 33 under 35 U.S.C. § 103(a) as unpatentable over Furman and Paik.

DECISION

To summarize, our decision is as follows.

- The rejection of claim 36 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention is not sustained.
- The rejection of claims 1, 4-16, 18-21, and 34-35 under 35 U.S.C. § 102(b) as being anticipated by Apte is sustained.
- The rejection of claims 22-25, 28, and 30-32 under 35 U.S.C. § 102(b) as being anticipated by Furman is not sustained.

- The rejection of claim 17 under 35 U.S.C. § 103(a) as unpatentable over Apte and Klingman is sustained.
- The rejection of claim 26 under 35 U.S.C. § 103(a) as unpatentable over Apte and Matsuda is sustained.
- The rejection of claim 29 under 35 U.S.C. § 103(a) as unpatentable over Furman and Matsuda is not sustained.
- The rejection of claims claim 33 under 35 U.S.C. § 103(a) as unpatentable over Furman and Paik is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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